

PATENT
Customer No. 22,852
Attorney Docket No. 07738.0147-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Grant E. DUBOIS et al.)	Group Art Unit: 1761
)	
Application No.: 09/838,809)	Examiner: Carolyn A. PADEN
)	
Filed: April 20, 2001)	
)	
For: NON CALORIC FROZEN)	Confirmation No.: 3526
CARBONATED BEVERAGE)	

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

VIA EFS-Web

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Further to the Notice of Appeal filed concurrently herewith, Applicant requests review, before the filing of an Appeal Brief, of the Final Office Action dated December 3, 2007, in the above-referenced application. No amendments are being filed with this request. Review is requested for the reasons stated in the five-page attachment to this paper, entitled "Arguments for Consideration." The undersigned is an attorney of record.

Respectfully submitted,

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Dated: June 3, 2008

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ARGUMENTS FOR CONSIDERATION

Claims 13, 14, 16, 17, 19, 20, 23, 26-28, 31, 34-37, 40, 42, 43, 54-90, 97-102, and 106-128 are pending in this application¹ and stand rejected in the Final Office Action dated December 3, 2007. This application describes and claims reduced calorie, and particularly non-caloric, frozen beverages. Far different from ordinary flavored icy drinks or homemade treats from residential freezers, the claimed beverages and systems (and methods of making them) generally focus on dispensing hard-to-freeze, low-caloric slush from mechanical mixers in a commercial setting, such as a convenience store. The present inventors overcame significant problems in attaining low-caloric slush by recognizing that certain freezing point depressants would allow for the proper dispensing of low-calorie, slushy beverages from standard mechanical mixing equipment. *See* Specification at [004] & [006]. Claim 13 is also instructive:

13. A frozen carbonated beverage dispenser system including a reduced calorie beverage for dispensing from a mechanical mixing chamber comprising:

- (a) a reduced calorie beverage syrup containing a mixture of high-potency non-caloric sweetener and a low caloric sugar, the low caloric sugar acting as a freezing point depressant;
- (b) water; and
- (c) carbon dioxide;

wherein the given freezing point is determined from a reference molal concentration of full-caloric sugar in standard frozen carbonated beverage for achieving said given freezing point, and then amount of low-caloric sugar in the mixture is selected to achieve substantially the same molal concentration thereof as the reference molal concentration; and

wherein the beverage is dispensable from a mechanical mixing chamber as a slush.

None of the cited references teach or suggest the systems, methods, and beverages of the pending claims. Even though the claims are rejected, the Office has essentially admitted novelty by lodging and maintaining a multiple-reference rejection under 35 U.S.C. § 102(e). That rejection is clearly improper and not in keeping with any recognized exception to the general requirement that anticipation be based on only one reference. For that reason alone, the pre-appeal panel should reopen prosecution and withdraw this improper § 102(e) rejection.

¹ See claim set presented with the Response filed October 31, 2007.

The references of record also do not support a *prima facie* case of obviousness. Nothing teaches or suggests the making and dispensing of reduced calorie beverages from mechanical mixing equipment. The Office has improperly disregarded recitations directed to the mixing equipment, which easily distinguishes the pending claims from references directed solely to home preparation of frozen beverages—a much different physical and chemical environment. Prosecution should be reopened to address and clarify those rejections, which upon reconsideration may well result in the allowance of the pending claims.

I. The Office Has Not Offered a Proper Rejection Under 35 U.S.C. § 102(e)

In the Final Office Action, the Office rejected claims 31, 34-37, 40, 42, 43, 54, 108-12, and 115-26 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Publication No. 2002/0136803 to *Stefandl* in view of U.S. Patent No. 5,380,541 to *Beyts* and further in view of the admitted state of the prior art at paragraph [002] of Applicant's specification, or U.S. Patent No. 5,806,550 to *Frank*. See Final Office Action at 2. "A claim is anticipated only if each and every element set forth in the claims is found either expressly or inherently described in a single prior art reference." See MPEP § 2131 (emphasis added). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s]." *Id.* Applicant submits that the Office's rejection clearly does not meet this long-standing test for anticipation.

As an initial matter, Applicant notes that the Office has vacillated between lodging this rejection under 35 U.S.C. § 102(e) and § 103(a).² In the most recent Final Office Action, the Office rejected the claims under § 102(e) but analyzed the rejection under § 103(a), even summarizing the rejection as allegedly "establish[ing] a *prima facie* case for obviousness." See Final Office Action at 2 & 5. At a minimum, the rejection is ambiguous and prosecution should be reopened to clarify the record, so as to avoid the need to brief the rejection under both statutory provisions without the benefit of a clear position from the Office.³

Stefandl does not teach, either expressly or inherently, the methods recited in claims 31, 34-37, 40, 42, 43, 54, 108, 109-112, and 115-126. The Office even admits that *Stefandl* fails to

² Compare Office Action dated December 3, 2007, at 2:8-11, and Office Action dated November 20, 2006, at 2:10-13 (both alleging anticipation); with Office Action dated July 3, 2007, at 2:8-11, and Office Action dated March 22, 2006, at 2:20-3:2 (both alleging only obviousness).

³ See, e.g., Official Gazette Notices dated July 12, 2005 (noting that the pre-appeal process is intended to "spare Applicants the added time and expense of preparing an appeal brief" when a pre-appeal conference would "identify the presence or absence of clearly improper rejections based upon error(s) in facts or . . . identify the omission . . . of essential elements required to establish *prima facie* rejections").

disclose certain elements of the pending claims, such as:

- (1) inclusion of a high intensity sweetener in the product (*see, e.g.*, claims 31, 34-37, 40, 42, 43, 54, 108, 109-112, and 115-126),
- (2) that sugar alcohols are sweeteners (*see, e.g.*, claims 34-36, 40, 42, 43, 54, 110-11, and 116-22),
- (3) the recited freezing point (*see, e.g.*, claims 31, 34-37, 40, 42, 43, 108, 109, 111, 112, and 115-126), and
- (4) the use of a commercial dispenser (*see, e.g.*, claims 31, 34-37, 40, 42, 43, 108, 109, 111, 112, and 115-126).

See Final Office Action at 3 (acknowledging *Stefandl*'s failure to disclose all elements of the claims). Therefore, the Office has admitted that *Stefandl* alone cannot anticipate the claims.

In an attempt to remedy *Stefandl*'s deficiencies, the Office cites *Beyts* and *Frank* in the context of this § 102(e) rejection. Multiple-reference § 102 rejections are generally proper only in certain limited instances, i.e., to prove an enabling disclosure, to explain a term's meaning, or to show an inherent characteristic. *See* MPEP § 2131.01. Yet none of those circumstances have been asserted by the Office to apply here, and indeed none apply. The "secondary" references, as well as the supposed admitted prior art ("APA"), fail to provide any pertinent missing information from *Stefandl* that could support the anticipation of the claimed systems, methods, and products. *Beyts* is generally directed toward synergistic sucralose compositions, while *Frank* is generally directed toward a method of mixing liquid and gas ingredients in a mixing chamber to affect beverage properties. The Office has improperly combined *Beyts* and *Frank* with *Stefandl* to allege anticipation and the rejection cannot stand.

The Office has admittedly failed to provide a single reference that may anticipate the pending claims, and has not made a proper multiple-reference anticipation rejection. Therefore, Applicant respectfully requests that prosecution be reopened and this rejection be withdrawn.

II. The Office Also Has Not Established a Proper *Prima Facie* Case of Obviousness for Those Claims Rejected with *Stefandl*, *Beyts*, *Frank*, and the Supposed APA

Assuming that the Office, despite its lack of clarity, sought to allege obviousness under 35 U.S.C. § 103(a), a *prima facie* case has not been made, providing yet another reason why the rejection over *Stefandl*, *Beyts*, *Frank*, and the supposed APA should be withdrawn. The standards for a proper obviousness rejection are well-known. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the present application would have been obvious. . . . [R]ejections on obviousness cannot be sustained with

mere conclusory statements.” MPEP § 2142 (citations omitted). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03.

The Office appears to allege that the *Stefandl* invention is substantially identical to the claimed inventions, but notes that *Stefandl* fails to disclose: (1) inclusion of a high intensity sweetener in the product, (2) that sugar alcohols are sweeteners, (3) the freezing point of the invention, and (4) the use of a commercial dispenser. *See* Final Office Action at 3. But *Stefandl* has an over-arching, more fundamental difference—it fails to disclose a beverage capable of being dispensed from a mechanical dispenser. *Stefandl* is directed only to a product that is frozen in a household freezer and then consumed under normal ambient conditions. The beverages of the present inventions differ for at least the reason that they are formulated for direct dispensing from a dynamic mixing dispenser, not pulled from a static unit like a home refrigeration system. *See* Response dated February 22, 2005, at 15-16. The environment recited by the pending claims—a mechanical mixing chamber or dispenser—from which the beverage is dispensed is a physical limitation and cannot be ignored for the purposes of patentability. *See* Response dated September 22, 2006, at 22-24. Moreover, as also discussed in previous responses, a composition that is capable of freezing under home freezer conditions is simply not the same as a composition that can be dispensed from a mechanical dispensing device. The skilled artisan would readily recognize those differences.

The Office then attempts to support its vast oversimplification of the comparison between *Stefandl* and the pending claims by citing to *Beyts* and *Frank*. But *Beyts* and *Frank* do not remedy the deficiencies of *Stefandl*. Nothing within *Beyts* teaches or suggests that its disclosed beverages are appropriate for dispensing from a mechanical mixing chamber. And neither *Stefandl* nor *Beyts* teach or suggest that their beverages would be capable of being dispensed from the mechanical dispenser of *Frank*, or vice versa. *See* Response dated October 31, 2007, at 2-3. Thus, any combination of the cited references fails to render obvious the claimed inventions. Applicant also points out that the burden rests with the Office to establish a *prima facie* case of obviousness and show that the claimed subject matter would have been obvious to the skilled artisan. By failing to properly articulate an obviousness position, the Office improperly shifts its burden to the Applicant and then requires Applicant to rebut that position.

Quite simply, before the present inventions, a viable reduced calorie or non-caloric beverage from a commercial, mechanical beverage dispenser had not been successfully made.

See Response dated October 31, 2007, at 2-3. Applicant, for the first time, produced a beverage syrup from a mixture of high-potency, non-caloric sweetener and a low-caloric sugar (e.g., a Sugar MNS) that is dispensable from a mechanical dispensing device. The prior art does not teach or suggest that result, and certainly not with any reasonable expectation of success. See Response dated September 22, 2006, at 23-24. As such, Applicant respectfully submits that the rejections should be withdrawn, or at a minimum prosecution should be reopened to clarify them, if in fact the Office intended to reject the claims under § 103(a) rather than § 102(e).

III. The Rejections Under 35 U.S.C. § 103(a) Based on *Marulich* Are Also Improper

The Office further rejected claims 13, 14, 16, 17, 19, 20, 23, 26-28, 31, 34, 35, 37, 40, 42, 43, 54-90, 97-102, and 106-27 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 3,826,829 to *Marulich* in view of *Beyts*, and in some instances in further combination with one or more of U.S. Patent No. 4,452,824 to *Cole*, U.S. Patent No. 6,066,345 to *de Cock*, and U.S. Patent No. 6,432,464 to *Andersen*. See Final Office Action at 5-9.

Marulich, like *Stefandl*, is concerned with producing slush beverages in a home freezer. For the reasons of record and those discussed above, there is no suggestion that the beverage of *Marulich*, alone or in combination with the other references, is capable of being dispensed from a mechanical, dynamic commercial dispenser; in fact, *Marulich* does not teach a dispenser beverage at all. See Response dated September 22, 2006, at 24-25. Furthermore, for example, *Marulich* does not teach or suggest a non-caloric frozen dispenser beverage containing erythritol as a freezing point depressant. See Response dated September 22, 2003, at 22. The secondary references do not cure those deficiencies in any manner that would have rendered the claims obvious to the skilled artisan. As such, those rejections are improper and should be withdrawn.

IV. Conclusion

While the Office and the Applicant may disagree as to the application of certain obviousness rejections, there can be no disagreement that the Office's multiple-reference rejection under 35 U.S.C. § 102(e) is ambiguous at best. For at least that reason, it is essential that the Office reopen prosecution to clarify the record. The § 102(e) rejection based on *Stefandl* is improper and should be withdrawn, and if the Office seeks to clarify and base the rejection upon § 103(a) it is also improper. The obviousness rejections based on *Marulich* similarly cannot stand as entered. Therefore, Applicant requests that the pre-appeal panel, at a minimum, reopen prosecution to clarify the record for further proceedings in examination and on appeal.